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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,387	10/23/2003	Joseph C. Salamone	P03005-D3	8480
7590	12/01/2004		EXAMINER	
RITA D. VACCA			PENG, KUO LIANG	
BAUSCH & LOMB INCORPORATED				
ONE BAUSCH & LOMB PLACE			ART UNIT	PAPER NUMBER
ROCHESTER, NY 14604-2701			1712	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/692,387	SALAMONE ET AL.
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 10/8/04 Preliminary amendment.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 14, 15, 18 and 21-26 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14, 15, 18 and 21-26 is/are rejected.
- 7) Claim(s) 18, 22 and 25 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| <input type="checkbox"/> Notice of References Cited (PTO-892)  | <input type="checkbox"/> Interview Summary (PTO-413)                     |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .   |
| <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/23/03</u> . | <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. The Applicants' preliminary amendment filed on October 8, 2004 was received. Claims 1-13, 16-17 and 19-20 are deleted. Claims 14, 15 and 18 are amended. Claims 21-26 are added.

### ***Claim Objections***

2. Claims 18, 22 and 25 are objected to because of the following informalities:

In Claims 22 (5<sup>th</sup> line from bottom) and 25 (6<sup>th</sup> line from bottom), should "hydrophob" be -- hydrophobic --?

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. When the embodiment of Claim 18 depends on Claims 14-15, 22-23 and 25-26, the following rejection applies.

5. Claims 14-15, 18, 22-23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaylord (US 3,808,178).

Gaylord discloses a method of producing ophthalmic devices such as contact lenses obtained by casting, molding or machining the a polymeric composition produced through the polymerization of a polysiloxanylalkyl ester monomer containing aromatic based groups and alkanol ester comonomers. (col. 1, line 18 to col. 3, line 44 and Examples). Gaylord further teaches the use of a hydrophilic monomer (col. 4, lines 50-62). Gaylord further teaches the use of methyl methacrylate (col. 3, line 29). Gaylord further teaches the use of a crosslinking agent such as ethylene glycol dimethacrylate, butylene glycol dimethacrylate, neopentyl glycol diacrylate, etc. (col. 5, lines 6-14).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. When the embodiment of Claim 18 depends on Claims 21 and 24, the following rejection applies.

8. Claims 18, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord.

Gaylord discloses a method of producing ophthalmic devices, supra, which is incorporated herein by reference. Gaylord is silent on the use of a non-siloxyl aromatic-based monomer. However, Gaylord teaches that an aromatic-based substituent can increase the refractive index of the polymeric composition, while the siloxanyl moieties can decrease the refractive index of the polymeric composition. Gaylord further teaches that the importance of the refractive index for an ophthalmic device. (col. 5, lines 15-30) Furthermore, as mentioned previously, Gaylord teaches the use of alkanol ester comonomers. (col. 3, lines 26-44) In light of which, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to introducing aromatic-based groups into the alkanol ester comonomers in order to effectively increase the refractive index without further introducing refractive-reducing siloxanyl moieties with expected successs.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1712

klp

November 24, 2004

Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712

  
**KUO-LIANG PENG**  
**PRIMARY EXAMINER**